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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,369	11/06/2003	Marc S. Gorans	294.00170101	8480

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EXAMINER

VALENTI, ANDREA M

ART UNIT PAPER NUMBER

3643

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/702,369

Applicant(s)

GORANS ET AL.

Examiner

Andrea M. Valenti

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 14 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/346,981 and claims 1-29 of U.S. Patent No. 5,651,731. Although the conflicting claims are not identical, they are not patentably distinct from each other because all teach at least one non-contact energy source for treating the lower beak of a bird with a head positioning device with an aperture. Merely, eliminating an element and its function i.e. a secondary energy director does not present a patentably distinct limitation. Furthermore, merely pressing inward on the throat is an inherent step of inserting the bird into the head positioning device for a secure fit to reduce movement of the animal and thus reduce possible injury to the animal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,446,819 to Gourlandt in view of Netherlands Patent NL 8802812A to Meyn.

Regarding Claim 1 and 15, Gourlandt teaches a method of treating the beak of a bird, the method comprising: positioning a bird head in a bird head positioning device (Gourlandt Fig. 7 #30), wherein the bird head positioning device comprises first and second major sides, and a beak receiving aperture formed through the first and second major sides of the bird head positioning device, wherein at least a portion of the lower beak of the bird head protrudes through the beak receiving aperture (Gourlandt Fig. 6 #56) and is exposed proximate the second major side of the bird head positioning device; inherently pressing inward on the throat of the bird **proximate** the base of the lower beak (Gourlandt teaches that element #62 goes between the bird's upper and lower beak Col. 4 line 51-59/Col. 7 line 45-51 and thus it is inherently pressing inward **on** the throat when the bird's head is held in position in element #30; applicant has merely claimed "proximate" the base which merely means nearby or close to), wherein the pressing is directed towards the tongue of the bird; debeaking and burning the beak at the second major surface of the bird head positioning device, wherein the beak

Art Unit: 3643

exposed proximate the second major side of the bird head positioning device while pressing inward on the throat of the bird (Gourlandt teaches the head is immobilized in the head restraint and thus the head is pressed inward to maintain the immobile position in the head device); teaches that either the top or bottom or both beaks can be treated (Gourlandt Col. 5 line 52-55).

Gourlandt is silent on emitting energy from a non-contact energy source. However, Meyn teaches the same type of treatment utilizing a known alternate energy source (Meyn #5 laser). It would have been obvious to one of ordinary skill in the art to modify the teachings of Gourlandt with the teachings Meyn of at the time of the invention since the modification is merely an engineering design choice involving the selection of a known alternate equivalent treatment source (i.e. mechanical versus laser) for the advantage of a more precise and cleaner cut and to reduce the likelihood of transmitting disease from one bird to another.

Regarding Claim 2, Gourlandt as modified teaches the pressing is performed while the bird head is positioned in the bird head positioning device (Gourlandt teaches the bird is inserted and suspended in the device thus it is inherently pressed on by first the hand inserting it and then by element #66).

Regarding Claim 3, Gourlandt as modified teaches the pressing is performed after the bird head is positioned in the bird head positioning device (Gourlandt #66).

Regarding Claims 4 and 5, Gourlandt as modified is silent on adjusting a force used to perform the pressing or limiting a force used to perform the pressing. However, it would have been obvious to one of ordinary skill in the art to further modify the

Art Unit: 3643

teachings of Gourlandt at the time of the invention to prevent from causing injury to the bird and based on the size of the bird.

Regarding Claims 6 and 11, Gourlandt teaches the bird head positioning device comprises a tongue control protrusion, wherein the tongue control protrusion presses into the throat of the bird proximate the base of the lower beak (Gourlandt Col. 4 line 51-59, element #62 is inserted in the mouth of the bird and is thus inherently functions as a tongue control that press into the throat, once again applicant has merely claimed "proximate" the lower beak).

Regarding Claim 7, Gourlandt as modified is silent on adjusting a force used to perform the pressing or limiting a force used to perform the pressing. However, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Gourlandt at the time of the invention to prevent from causing injury to the bird and based on the size of the bird.

Regarding Claims 8 and 15, Gourlandt as modified teaches the tongue control protrusion extends into the beak receiving aperture (Gourlandt Fig. 6 and Col. 4 line 51-59 and Fig. 7 illustrates element #62 inside of the aperture in element #30).

Regarding Claims 9, 13 and 17, Gourlandt as modified is silent on explicitly teaching adjusting a distance by which the tongue control protrusion extends into the beak receiving aperture. However, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Gourlandt at the time of the invention since the modification is merely making something adjustable while performing the same intended function, modified to accommodate different size birds. Making something adjustable

Art Unit: 3643

does not present a patentably distinct limitation [*In re Stevens*, 212 F.2d 197, 198, 101 USPQ 284, 285 (CCPA 1954)].

Regarding Claims 10, 12 and 16, Gourlandt as modified teaches the tongue control protrusion extends into the beak receiving aperture by a fixed distance (Gourlandt Fig. 6 #62).

Allowable Subject Matter

Claims 14 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Examiner maintains that Gourlandt teaches that the control protrusion presses into the throat of the bird proximate the base of the lower beak. Since Gourlandt element #66 presses on the back of the head of the bird, then element #62 presses into the throat of the bird.

Examiner suggests applicant cancel claim 1 and its dependent claims and more precisely define the structure of the tongue protrusion in claim 6 and the remaining independent claims. For example, the tongue protrusion is located between the undersurface of the bird's head and the lower portion of the head restraining aperture, that the head restraint aperture has a top and lower surface facing each other respectively and that the tongue protrusion extends directly up from the lower surface.

Art Unit: 3643

The examiner is not suggesting these exact words, but merely the concept of more clearly structurally defining the features of the tongue protrusion and its relationship with the head restraint aperture.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 571-272-6895. The examiner can normally be reached on 7:00am-5:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Andrea M. Valenti
Patent Examiner
Art Unit 3643

29 March 2006


Peter M. Poon
Supervisory Patent Examiner
Technology Center 3600

4/13/06